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CASCA, FRED A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,237

Applicant(s)

HICKETHIER ET AL.

Examiner

FRED A. CASCA

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/302)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Independent claims 9 and 17 recites the limitation "wherein the destination mobile switching center converts the PLMN-BC information element into an Integrated Services Digital Network (ISDN) User Part (ISUP)-compliant (ISDN-BC) information element."

There is insufficient antecedent basis for this limitation in the claim. It is not clear how a PLMN-BC information element is converted into an Integrated Services Digital Network (ISDN) User Part (ISUP)-compliant (ISDN-BC) information element.

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Claims 9-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 9 and 17 have been amended to contain new matter. The phrase

“PLMN-BC information element is converted into an Integrated Services Digital Network (ISDN) User Part (ISUP)-compliant (ISDN-BC) information element” added to independent claims 9 and 17 has not been described in the specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-11, 14, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 2003/0027570 A1) in view of Harada et al (US 5,572,524 A1) and further in view of Basilier et al (US 2003/0233457 A1).

Referring to claim 9, Yang discloses a method of backward-signaling of a transmission service used for setting up a call from a telecommunication network (abstract and Fig. 1), comprising calling, from the telecommunication network (Fig. 1 and Par. 15 “PSTN”), a mobile terminal (Fig. 1 and Par. 15, line 12) in a service area of a destination mobile switching center (Fig. 1 and Par. 15) in a digital mobile radio network via an access mobile switching center (Fig. 1 and Par. 15, “serving MSC”).

Yang further discloses information being stored in destination MSC (Par. 18, 20, 25, “serving MSC realizes that the first voice path includes links”, note the MSC inherently does such realization based on the information stored in the MSC)

Yang does not specifically disclose negotiating transmission service to be used for the call, including at least a Bearer Capability (PLMN-BC) information element, wherein the destination mobile switching center converts the PLMN-BC information element into an Integrated Services Digital Network (ISDN) User Part (ISUP)-compliant (ISDN-BC) information element, and wherein the information is transported using at least one ISUP message at least to an access mobile switching center to effect the backward signaling.

Harada discloses a communication system that allows setting up a call between different networks and determining bearer capability (abstract, Figs. 1-4, col. 12, lines 55-67 and col. 13, lines 1-3, "when set-up message for setting up a call is received from ISDN ... determines whether the bearer capability BC contained in the SET-UP message").

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of Yang by incorporating the teachings of Harada and consequently providing negotiating, between the mobile terminal and the destination mobile switching center, information describing the transmission service to be used including the Bearer Capability, for the purpose providing an efficient communication system.

The combination of Yang/Harada does not specifically disclose converting the PLMN-BC information element into an Integrated Services Digital Network (ISDN) User Part (ISUP)-compliant (ISDN-BC) information element, and storing in the destination mobile switching center and is transported using at least one ISUP message at least to an access mobile switching center to effect the backward signaling, in the format claimed.

Basilier discloses converting different messages (e.g., SIP messages) to ISDN User Part (ISUP), Par. 25, "converts SIP messages into a different format, such as ISDN User Part").

It would have been obvious to one of the ordinary skill in the art the time of invention to modify the above combination such that the PLMN-BC information element is converted into an Integrated Services Digital Network (ISDN) User Part, and then transporting it using an ISUP message, as disclosed by Basilier, for the purpose of providing an efficient communication system.

Referring to claim 10, the combination of Yang/Harada/Basilier discloses the method according to claim 9, and further discloses the telecommunication network is an ISDN, a Public Switched Telephone Network (PSTN), or a Public Land Mobile Network (PLMN) (Yang, Fig. 1).

Referring to claim 11, the combination of Yang/Harada/Basilier discloses the method according to claim 9, wherein the information is transported using at least one ISDN User Part (ISUP) message (Basilier, Par. 25).

Referring to claim 14, the combination of Yang/Harada/Basilier discloses the method according to claim 9, and further discloses the information is evaluated in the access mobile switching center in order to execute transmission service specific functions contained therein (Yang, Par. 20-25).

Referring to claim 15, the combination of Yang/Harada/Basilier discloses comprising transmitting the information to at least one network node in the digital mobile radio network or in the telecommunication network to be involved in the call (Fig. 1 and Par. 13-18).

Claim 17 recites features analogous to the features of claim 9. Thus, the combination of Yang/Harada/Basilier discloses all elements of claim 17.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 2003/0027570 A1) in view of Harada et al (US 5,572,524 A1) and further in view of Basilier et al (US 2003/0233457 A1) and still further in view of Williams (2003/0099341 A1).

Referring to claim 12, the combination of Yang/Harada/Basilier discloses the method according to claim 11.

The above combination does not disclose wherein the at least one ISUP message is an Address Complete Message (ACM), an Answer Message (ANM), a Connect Message (CON), or a Call Progress Message (CPG).

Williams discloses that an ISUP message is an Address Complete Message (ACM), an Answer Message (ANM), a Connect Message (CON), or a Call Progress Message (CPG) (Par. 34).

It would have been obvious to one of the ordinary skill in the art the time of invention to modify the above combination in the format claimed for the purpose of providing an efficient communication system.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 2003/0027570 A1) in view of Harada et al (US 5,572,524 A1) and further in view of Basilier et al (US 2003/0233457 A1) and further in view of Hirani (US 2004/0198326 A1).

Referring to claim 13, the combination of Yang/Harada/Basilier discloses the method according to claim 11.

The combination is silent on the information being made available in an optional Access Transport parameter in the at least one ISUP message.

Hirani discloses information is made available in an optional Access Transport parameter in the at least one ISUP message (Par. 23).

It would have been obvious to one of the ordinary skill in the art the time of invention to modify the above combination in the format claimed for the purpose of providing an efficient communication system.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 2003/0027570 A1) in view of Harada et al (US 5,572,524 A1) and further in view of Basilier et al (US 2003/0233457 A1) and still further in view of Kauhanen et al (US 2004/0076145 A1).

Referring to claim 16, the combination of Yang/Harada/Basilier discloses the method according to claim 9.

The combination does not specifically disclose wherein the information comprises a Low Layer Compatibility information element (LLC) or a High Layer Compatibility information element (HLC).

Kauhanen discloses information comprising a Low Layer Compatibility information element (LLC) or a High Layer Compatibility information element (HLC) (Par. 32-37).

It would have been obvious to one of the ordinary skill in the art the time of invention to modify the above combination in the format claimed for the purpose of providing an efficient communication system.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper, can be reached at (571) 272-7605. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617